

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. **0771MH-60032-US**

In Re Application of:

FRED A. ANTONINI

Serial No.: **10/523,942**

Filed: **8 FEBRUARY 2005**

For: **SILICONE-ELASTOMER FILM
AND METHOD OF
MANUFACTURING SAME**

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Examiner: **ALICIA ANN CHEVALIER**

Confirmation No.: **8554**

Art Unit: **1794**

APPEAL BRIEF

MAIL STOP: APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an appeal from the Final Rejection dated 25 June 2008, finally rejecting claims 1, 2, 4-25, and 36-40 in the present Application. A Notice of Appeal was filed on 20 September 2008. Thus, the two-month date for filing an Appeal Brief is 20 November 2008.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8(a)(1)(i)(C)
Date of Transmission: 19 November 2008
I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office (USPTO) via the USPTO electronic filing system (EFS-Web) on the date shown above.
By: <u>/darencdavis#38425/</u> Daren C. Davis

Payment of the \$540.00 fee for filing a brief in support of an appeal is being made concurrently via EFS-Web with the filing of this Appeal Brief. No other fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. **502806**.

Please link this Application to Customer No. 38441 so that its status may be checked via the PAIR System.

If no separate Petition for Extension of Time is filed herewith, this document is to be construed as also constituting a Petition for Extension of Time under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such Petition for Extension of Time and any other fee required by this document and not submitted herewith should be charged to Deposit Account No. **502806**. Any refund should be credited to Deposit Account No. **502806**.

Real Party in Interest (37 C.F.R. § 41.37(c)(1)(i)):

The real party in interest in the present Application is the sole inventor, Fred A. Antonini.

Related Appeals and Interferences (37 C.F.R. § 41.37(c)(1)(ii)):

There are no related appeals or declared interferences that will directly affect or be directly affected by a decision by the Board of Patent Appeals and Interferences (the “Board”) in the present appeal to the knowledge of the undersigned.

Status of Claims (37 C.F.R. § 41.37(c)(1)(iii)):

The present Application, which is an application filed on 8 February 2005 under 35 USC § 371 from International Patent Application Serial No. PCT/US04/06552 filed on 3 March 2004 under the Patent Cooperation Treaty claiming the benefit of U.S. Provisional Patent Application Serial No. 60/500,311, filed on 4 September 2003, was originally filed with 35 claims (*i.e.*, claims 1-35).

In Appellant's amendment dated 9 April 2007 in response to the Office Action of 2 February 2007, claims 26-35 were canceled and new claims 36-40 were added. In Appellant's amendment dated 12 March 2008, claim 3 was canceled and no new claims were added. Thus, claims 1, 2, 4-25, and 36-40 are presently under consideration in the appealed Application.

In a Final Office Action dated 25 June 2008 ("Final Office Action"), the Office Action Summary indicates that claims 1, 2, 4-25, and 36-40 are finally rejected and that no claims are allowed or objected to.

The status of the claims is, therefore, believed to be as follows:

Allowed claims:	None
Claims objected to:	None
Claims rejected:	1, 2, 4-25, and 36-40.

Appellant hereby appeals the Examiner's final rejection of the foregoing claims (*i.e.*, claims 1, 2, 4-25, and 36-40), which presently stand rejected over the cited references. Appealed claims 1, 2, 4-25, and 36-40 are set forth in a Claims Appendix, attached hereto, pursuant to 37 C.F.R. § 41.37(c)(1)(viii).

Status of Amendments (37 C.F.R. § 41.37(c)(1)(iv)):

Appellant filed no amendments subsequent to the Final Office Action.

Summary of Claimed Subject Matter (37 C.F.R. § 41.37(c)(1)(v)):

The independent claims involved in the present appeal relate, in general, to a film comprising a thin layer of silicone elastomer disposed on a dimensionally stable, thin plastic film.

Independent claim 1 relates to a film 11 (Specification, p. 5, l. 18, and Figure 1) comprising a dimensionally stable, thin plastic film 15 (Specification, p. 6, ll. 7-9, and Figure 1) having a smooth surface finish (Specification, p. 6, l. 9, and Figure 1) and a thin layer (Specification of U.S. Provisional Patent Application Serial No. 60/500,311, p. 2, l. 20, and Figure 1 of the present Application) of silicone elastomer 13 (Specification, p. 5, l. 21, and Figure 1) disposed on a first surface 17 of the plastic film 15 (Specification, p. 5, l. 22, and Figure 1). The thin layer of silicone elastomer 13 has a durometer of less than 30 on the Shore A scale (Specification of U.S. Provisional Patent Application Serial No. 60/500,311, p.2, ll. 20-21, and Figure 1 of the present Application).

Independent claim 36 relates to a silicone elastomer film 11 (Specification, p. 5, l. 18, and Figure 1) comprising a heat-stabilized, plastic film 15, 73 (Specification, p. 8, l. 2) having a surface 17 (Specification, p. 5, l. 22, and Figure 1) and a silicone elastomer coating 13 (Specification, p. 5, l. 21, and Figure 1) disposed on the surface 17 of the film 15, 73.

Independent claim 40 relates to a silicone elastomer film 25 (Specification, p. 6, l. 27, and Figure 4) comprising a heat-stabilized, plastic film 31, 73 (Specification, p. 8, l. 2, and Figure 4) exhibiting a surface energy of less than about 40 Dynes per centimeter (Specification, p. 4, ll. 19-20, and Figure 4) and a silicone elastomer layer 27 (Specification, p. 6, l. 29, and Figure 4) disposed on a first surface 29 (Specification, p. 6, l. 29, and Figure 4) of the heat-stabilized, plastic film 31, 73. The silicone elastomer layer 27 exhibits a durometer of less than about 40 on the Shore A scale (Specification, p. 4, l. 18) and defines a plurality of dimples 21 (Specification, p. 5, l. 24, and Figure 3) extending outwardly from an exposed surface 33 (Specification, p. 6, l. 30, and Figure 4) of the silicone elastomer layer 27. The silicone elastomer film 25 further comprises a release liner 39 (Specification, p. 6, l. 32, and Figure 4) and an adhesive (Specification, p. 6, l. 32,

and Figure 4) adhered to a second surface 37 (Specification, p. 6, l. 32, and Figure 4) of the heat-stabilized, plastic film 31, 73 and releasably adhered to a surface of the release liner 39 (upper surface of the release liner 39 in Figure 4) (Specification, p. 6, l. 31, through p. 7, l. 1, and Figure 4).

Grounds of Rejection to be Reviewed on Appeal (37 C.F.R. § 41.37(c)(1)(vi)):

Issue No. 1. Claims 1, 2, 4-25, and 36-40 stand rejected under 35 USC § 103(a), as being unpatentable over U.S. Patent 6,372,323 to Kobe *et al.* (“Kobe”) in view of U.S. Patent 5,300,171 to Braun *et al.* (“Braun”) and evidenced by U.S. Patent 6,960,272 to Tokas *et al.* (“Tokas”). Thus, the issue is whether the teachings of Kobe, Braun, and Tokas disclose or suggest all of the limitations of the rejected claims as necessary for establishing a *prima facie* case of obviousness.

Argument (37 C.F.R. § 41.37(c)(1)(vii)):

I. The Legal Standard for Obviousness Rejections Under 35 USC § 103

In the consideration and determination of obviousness under 35 U.S.C. 103, the four factual inquiries¹ used as a background for determining obviousness are (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations. In determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.² A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention.³ The U.S. Supreme Court reinforces this principle in its decision in *KSR Int'l. Co. v. Teleflex, Inc.*,⁴ stating that “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”⁵

It is legally insufficient to conclude that a claim is obvious “merely by demonstrating that each of its elements was, independently, known in the prior art.”⁶ When the claimed invention is not a “predictable use of prior art elements according to their established functions,” the claimed invention cannot be found to be obvious.⁷ For example, when the elements of the claimed invention work together “in an unexpected and fruitful manner,” the claimed invention was not obvious to one skilled in the art at the time of the invention.⁸ Moreover, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational

¹ See *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

² MPEP 2141.02, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

³ MPEP 2141.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

⁴ *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. ____ (2007).

⁵ *KSR*, slip op. at 12, citing *United States v. Adams*, 383 U.S. 39, 40 (1966).

⁶ *KSR*, slip op. at 14.

⁷ *KSR*, slip op. at 13.

⁸ *KSR*, slip op. at 12.

underpinning to support the legal conclusion of obviousness.”⁹ The Office must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”¹⁰ The Office must also make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.”¹¹ Anything less than such an explicit analysis is insufficient to support a *prima facie* case of obviousness. Such an analysis must not “read into the prior art the teachings of the invention in issue” and must “guard against slipping into the use of hindsight.”¹²

**II. Issue No. 1 –
Rejection Under 35 USC § 103(a) Over Kobe, Braun, and Tokas:**

Claims 1, 2, 4-25, and 36-40 stand rejected under 35 USC § 103(a), as being unpatentable over Kobe in view of Braun and evidenced by Tokas. Appellant respectfully traverses the rejection because neither Kobe, Braun, nor Tokas, whether taken singly or in combination, render the claimed invention obvious for at least the reasons set forth *infra*. Appellant respectfully requests reversal of the rejection.

A. Claims 1, 2, and 4-25 are allowable over the cited references

Independent claim 1 requires “a dimensionally stable, thin plastic film” and “a thin layer of silicone elastomer *having a durometer of less than 30 on the Shore A scale* disposed on a first surface of the plastic film” (emphasis added). It should be noted that the Office relies upon only Kobe and Braun in the rejection of claim 1. The Office alleges that Kobe’s additional backing layer 22 is the claimed plastic film and that Kobe’s backing layer 21 with stems 26 make up the claimed layer of silicone elastomer.¹³ The Office acknowledges that “Kobe fails to disclose that the silicone elastomer has a low durometer,

⁹ KSR, slip op. at 14, citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

¹⁰ KSR, slip op. at 15.

¹¹ KSR, slip op. at 14.

¹² KSR, slip op. at 17.

¹³ Detailed Action, p. 3, ll. 19-21.

more specifically less than 40 on the Shore A scale”¹⁴ but relies upon Braun to teach this limitation.¹⁵ Appellant respectfully submits, however, that Braun fails to disclose a silicone elastomer having a durometer of *less than 30* on the Shore A scale, as required by claim 1. The characteristic of having a durometer of less than 30 on the Shore A scale provides critical frictional properties to the claimed film¹⁶ and, thus, the durometer is not merely a result effective variable, as alleged by the Office.

Appellant respectfully asserts that the present invention, as set forth in independent claim 1, would not have been obvious to one of ordinary skill in the art at the time of the invention. One of ordinary skill in the art would have appreciated that it would not be desirable to use a silicone elastomer having a durometer of less than 30 on the Shore A scale, as required by claim 1, in the upstanding stems of Kobe because such silicone elastomers exhibit shear strengths that are lower than desirable for Kobe’s article.¹⁷ Moreover, one of ordinary skill in the art at the time of the invention would have appreciated that silicone elastomers having durometers of less than 30 on the Shore A scale are difficult to bond to other materials and, thus, such a person would have avoided using such silicone elastomers in implementations wherein the silicone elastomer was applied to another material.¹⁸

The Office has deemed the Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, dated 10 March 2008, (“the Declaration”) as unpersuasive “because it only contains ANTONINI’s opinions and arguments concerning the prior art.”¹⁹ Appellant respectfully but strongly traverses the Office’s contention. In the Declaration, Mr. Antonini establishes himself as being knowledgeable of ordinary skill in the art.²⁰ Using this knowledge, Mr. Antonini explains in the Declaration why it would not have been obvious to one of ordinary skill in the art at the time of the present invention to dispose a thin layer of silicone elastomer having a durometer of less than 30 on the Shore A scale on a surface of a

¹⁴ Detailed Action, p. 4, ll. 6-7.

¹⁵ Detailed Action, p. 4, ll. 20-21.

¹⁶ Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 6.

¹⁷ *Id.*, ¶ 7.

¹⁸ *Id.*, ¶ 7.

¹⁹ Detailed Action, p. 9, l. 6.

²⁰ Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶¶ 3-6.

dimensionally stable, thin plastic film, as required by each of the rejected claims.²¹ Moreover, Mr. Antonini explains in the Declaration why one of ordinary skill in the art at the time of the present invention would not have found it desirable to use a silicone elastomer having a durometer of less than 30 on the Shore A scale in the Kobe article.²² The Office, however, has completely discounted Mr. Antonini's knowledge of ordinary skill in the art, as well as his detailed explanations as to why one of ordinary skill in the art would not find the present invention, as set forth in the rejected claims, obvious. Rather, the Office baldly states that the Declaration is "unpersuasive because it only contains ANTONINI's opinions and arguments regarding the prior art."²³ It is the Office's burden to refute Appellant's evidence, *i.e.*, the Declaration, with evidence, not mere hearsay. The Examiner appears to be drawing upon her own personal knowledge in the allegation that "the exact durometer of the silicone elastomer layer is deemed to be a result effective variable."²⁴ while the Examiner may rely upon such personal knowledge, the Examiner's ability to use personal knowledge is qualified by 37 CFR 1.104(d)(2), which states:

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

In light of Mr. Antonini's explanation in the Declaration, Appellant respectfully requests an affidavit executed by the Examiner supporting the Office's contention. Absent such an affidavit executed by the Examiner, the contentions proffered by the Office are merely bald allegations without any evidentiary support, cannot overcome evidence properly provided in the Declarations, and are insufficient to establish a *prima facie* case of obviousness.

The Office also contends that "Applicant's specification also discloses that a durometer of less than 40 on the Shore A scale is also with in [*sic*] the scope of the invention."²⁵ Appellant respectfully submits that this fact has no bearing on the

²¹ Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 9.

²² Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 10.

²³ Detailed Action, p. 9, I. 6.

²⁴ Detailed Action, p. 4, II. 10-11.

²⁵ Detailed Action, p. 10, II. 5-6.

patentability of the rejected claims, as the rejected claims require a silicone elastomer having a durometer of less than 30 on the Shore A scale.

Accordingly, as recited in claim 1, “a dimensionally stable, thin plastic film” works together with “a thin layer of silicone elastomer *having a durometer of less than 30 on the Shore A scale* disposed on a first surface of the plastic film” in an unexpected and fruitful manner. Thus, the present invention, as set forth, in claim 1, cannot be obvious in light of Kobe, Braun, and Tokas. Claims 2 and 4-25 depend from claim 1; therefore, the remarks provided *supra* concerning claim 1 apply equally to claims 2 and 4-25.

B. Claims 6-10 are separately allowable over the cited references

Claim 6 further requires the silicone elastomer to have “a polished surface finish.” The Office alleges that “the limitation ‘polished’ is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results.”²⁶ Moreover, the Office states that “Applicant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art.”²⁷

Concerning the Office’s allegation that the limitation “polished” is a method limitation, Appellant reiterates his traversal of this allegation, as the limitation “polished” is not a method limitation but is, instead, structural in nature.

In *In re Garnero*,²⁸ the CCPA held certain limitations to be structural rather than process limitations. Claim 1 in *Garnero* recited:

*A composite, porous, thermal insulation panel characterized by dimensional stability and structural strength consisting essentially of expanded perlite particles which are interbonded one to another by interfusion between the surfaces of the perlite particles while in a pyroplastic state to form a porous perlite panel.*²⁹

²⁶ Detailed Action, p. 5, ll. 10-12.

²⁷ Detailed Action, p. 10, ll. 9-10.

²⁸ *In re Garnero*, 412 F.2d 276, 162 USPQ 221, 223 (CCPA 1969).

²⁹ *Garnero*, 162 USPQ at 222.

On appeal to the CCPA, the solicitor for the Patent Office argued that the limitation “interbonded one to another” was a process limitation that was not a patentable distinction over the prior art. The CCPA disagreed and held the limitation to be a structural limitation, stating that:

*it seems to us that the recitation of the particles as “interbonded one to another by interfusion between the surfaces of the perlite particles” is as capable of being construed as a structural limitation as “intermixed,” “ground in place,” “press fitted,” “etched,” and “welded,” all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations....*³⁰

This reasoning reads directly on the present case with only slight modification for the technologies involved. A “polished surface finish” is a structural limitation of the silicone elastomer, not merely the result of a process for making the silicone elastomer. Accordingly, “polished surface finish” must be given patentable weight.

The Office alleges “Kobe meets the limitation that the silicone elastomer has a polished surface finish, since figures 1 and 8 clearly show non-raised or flat portion on the article.”³¹ Claims, however, are construed in light of the specification, of which they are a part.³² The present Specification teaches “[t]he phrase ‘surface finish’ will be used herein to describe the surface of materials on a very fine, or microscopic, scale....”³³ While the drawings of Kobe show enlarged views, and in those views the surfaces of Kobe’s article may appear smooth, Kobe is completely silent with regard to any surfaces being having polished surface finishes, *i.e.*, polished on a microscopic scale, as required by claim 6. Not only must the prior art suggest the claimed invention, the prior art must disclose each

³⁰ *Garnero*, 162 USPQ at 223. See also *Hazani v. United States Int’l Trade Comm’n*, 12 F.3d 1473, 44 USPQ2d 1358, 1363 (Fed. Cir. 1997) (citing *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971)):

Hazani argues that the “chemically engraved” claims are product-by-process claims. We agree with the respondents, however, that those claims are best characterized as pure product claims, since the “chemically engraved” limitation, read in context, describes the product more by its structure than by the process used to obtain it.

³¹ Detailed Action, p. 5, ll. 16-18.

³² *Phillips v. AWH Corporation*, 415 F.3d 1303, 1315-16 (Fed. Cir. 2005).

³³ *WO 2005/026434*, p. 5, ll. 2-3.

and every element of the claimed invention.³⁴ The cited references, however, fail to meet this standard.

If the Office persists in its allegation that the limitation “polished” is a method limitation, Appellant respectfully requests the Office to provide evidence that the limitation should be considered a method limitation. If the Examiner is relying upon personal knowledge that one of ordinary skill in the art would understand the limitation to be considered a method limitation, Appellant has respectfully requested an affidavit executed by the Examiner supporting the contention.³⁵

Concerning the Office’s statement that “Applicant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art,”³⁶ Appellant respectfully asserts that the Office must proffer a *prima facie* case of obviousness, which the Office has failed to do, before Appellant is required to rebut the case with evidence:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

The Office has the burden to specify wherein the prior art each of the limitations can be found in order to make out a *prima facie* case of obviousness. Specifically, the Office must either point to wherein Kobe a polished surface finish is disclosed or provide evidence of why the Office believes Kobe’s surfaces are polished. Absent such a recitation by Kobe or such evidence, a *prima facie* case of obviousness cannot be made.

³⁴ *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

³⁵ Response to Office Action of 14 December 2007, p. 16, ll. 8-11.

³⁶ Detailed Action, p. 10, ll. 9-10.

Appellant respectfully requests the Office to provide evidence that Kobe's surfaces are polished. If the Examiner is relying upon personal knowledge that one of ordinary skill in the art would understand the surfaces of Kobe to be polished, Appellant continues to respectfully request an affidavit executed by the Examiner supporting the contention.

For at least these additional reasons, claims 6-10 are allowable over Kobe, Braun, and Tokas.

C. Claim 11 is separately allowable over the cited references

Claim 11 requires the texture to be "an array of upraised dimples," examples of which are shown in Figure 3. The Office alleges that "Kobe discloses that the textured is in an array of upraised dimples (*figures 1 and 8*)."³⁷ A dimple, however, for example, is "an indented, hollowed, or depressed area in the surface of something."³⁸ The Office contends that "the spaces between the projections are depression areas, e.g. dimples."³⁹ Appellant, however, respectfully maintains that Kobe fails to disclose an array of upraised dimples, as required by claim 11.

D. Claim 12 is separately allowable over the cited references

Claim 12 requires the silicone elastomer to have "a matte surface finish." The Office alleges that Kobe's silicone elastomer "is deemed to [have] a matte finish since it contains projections."⁴⁰ As discussed above concerning the rejection of claims 6-10, the present Specification teaches "[t]he phrase 'surface finish' will be used herein to describe the surface of materials on a very fine, or microscopic, scale...."⁴¹ Thus, Kobe is silent with regard to its article having matte finish in the same way that Kobe fails to teach or disclose its article having a polished finish.

The Office, however, contends that "Applicant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind

³⁷ *Detailed Action*, p. 6, ll. 9-10.

³⁸ See <http://encarta.msn.com/encnet/refpages/search.aspx?q=dimple>.

³⁹ *Detailed Action*, p. 10, ll. 17-18.

⁴⁰ *Detailed Action*, p. 6, ll. 11-12.

⁴¹ *WO 2005/026434*, p. 5, ll. 2-3.

from the prior art.”⁴² Rather, Appellant provided a specific reference to Appellant’s Specification to provide guidance in construing the claims in general and this limitation in particular. Such a reference is not merely “attorney argument.” “[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.”⁴³

The Office has arbitrarily deemed a surface having projections to be the claimed matte surface finish resulting in an allegation that is *prima facie* deficient. Appellant respectfully requests the Office to provide reasoned, technical evidence that a surface having projections should be construed as a matte finish. If the Examiner is relying upon personal knowledge that one of ordinary skill in the art would construe a surface having projections as a matte finish, Appellant respectfully requests an affidavit executed by the Examiner supporting the contention.

Accordingly, the present invention, as set forth in claim 12, is separately allowable over Kobe, Braun, and Tokas.

E. Claim 13 is separately allowable over the cited references

Claim 13 requires the plastic film to be “a heat stabilized plastic film.” The Office, however, construes the term “heat stabilized” as a method limitation.⁴⁴ The Office is reminded of the discussion *supra* concerning *In re Garnero*⁴⁵ with regard to claims 6-10. Therefore, Appellant respectfully asserts that the limitation “heat stabilized” provides a structural limitation to the plastic film.

The term “heat stabilized,” as it pertains to a plastic film, would be understood by those skilled in the art having the benefit of the disclosure in the above-referenced application to mean a film that is substantially dimensionally stable when subjected to

⁴² Detailed Action, p. 10, ll. 19-21.

⁴³ *Phillips v. AWH Corporation*, 415 F.3d 1303, 1315-16 (Fed. Cir. 2005).

⁴⁴ Detailed Action, p. 6, l. 13.

⁴⁵ *In re Garnero*, 412 F.2d 276, 162 USPQ 221, 223 (CCPA 1969).

heat.⁴⁶ Appellant respectfully asserts that the cited references, whether taken singly or in combination, neither disclose or suggest a heat stabilized plastic film.

If the Office wishes to persist in the rejection of claim 13, Appellant respectfully requests reasoned evidence that one or more of the cited references discloses a heat stabilized plastic film, as set forth in claim 13. If the Examiner is relying upon personal knowledge that one of ordinary skill in the art would understand the term “heat stabilized” to be a method limitation, Appellant respectfully requests an affidavit executed by the Examiner to that effect. Absent such an affidavit or other reasoned evidence, the rejection of claim 13 is *prima facie* deficient and should be withdrawn.

It should be noted that the Office contends that “the limitation ‘a heat stabilized plastic film’...has been addressed in the new grounds of rejection.” The Office, however, has provided no new grounds of rejection, as the rejection in the present Office Action of claim 13 is exactly the same as the rejection in the previous Office Action.

For at least these additional reasons, claim 13 is separately allowable over Kobe, Braun, and Tokas.

F. Claim 16 is separately allowable over the cited references

Claim 16 requires “graphical indicia associated with the plastic film.” The Office relies upon Kobe to disclose “the plastic film or silicone elastomer can be tinted with pigments or dyes (*col. 5, lines 62-67*).”⁴⁷ The cited portion of Kobe discloses:

The thermoplastic materials may also contain additives, including but not limited fillers, fibers, antistatic agents, lubricants, wetting agents, foaming agents, surfactants, pigments, dyes, coupling agents, plasticizers, suspending agents, hydrophilic/hydrophobic additives, and the like.

Kobe is describing, in general, the types of additives that its thermoplastic materials may contain. One of ordinary skill in the art would appreciate that these additives are of the type that are added to a batch of material, rather than to create a graphical indicia.

⁴⁶ Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 11.

⁴⁷ *Detailed Action*, p. 6, ll. 20-21 (emphasis in original).

While a graphical indicia may comprise pigment or a dye, merely stating that pigment or a dye may be included in its thermoplastic material does not meet the requirement that the prior art teach or suggest all of the claimed limitations. Claim 16 is, therefore, allowable over the cited references.

G. Claim 25 is separately allowable over the cited references

The Office has again failed in its burden to describe how the cited references are applied to claim 25. As in the Office Action of 14 December 2007, while claim 25 is listed in the Detailed Action as being rejected under 35 USC § 103(a) over Kobe, Braun, and Tokas, the Office has failed in its burden to describe how the cited references are applied to claim 25. The burden includes showing an objective teaching in the cited art that would lead one of ordinary skill in the art to combine the teachings of references.⁴⁸ If not “readily apparent,” the examiner must explain why the combination of references is proper.⁴⁹ No such explanation is provided. Appellant respectfully asserts that the cited references, whether taken singly or in combination, fail to disclose or suggest “a label stock having graphical indicia adhered to the plastic film, such that the graphical indicia is visible,” as required by claim 25. Accordingly, claim 25 is allowable over the cited references.

H. Claims 36-40 are allowable over the cited references

Independent claims 36 and 40 each recite “a heat-stabilized, plastic film.” While the Office contends that the limitation “heat-stabilized” is a method limitation,⁵⁰ it can be seen from the discussion provided *supra* concerning claim 13 that the term “heat stabilized,” as it pertains to a plastic film, would be understood by those skilled in the art having the benefit of the disclosure in the above-referenced application to mean a film that is substantially dimensionally stable when subjected to heat.⁵¹ Appellant respectfully asserts that the cited references, whether taken singly or in combination, neither disclose or suggest a heat stabilized plastic film.

⁴⁸ *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988).

⁴⁹ *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1790 (Bd. Pat. App. & Int. 1987).

⁵⁰ Detailed Action, p. 8, l. 16.

⁵¹ Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 8.

If the Office wishes to persist in the rejection of claims 36 and 40, Appellant respectfully requests reasoned evidence that one or more of the cited references discloses a heat-stabilized plastic film, as set forth in claims 36 and 40. If the Examiner is relying upon personal knowledge that one of ordinary skill in the art would understand the term “heat stabilized” to be a method limitation, Appellant continues to respectfully request an affidavit executed by the Examiner to that effect. Absent such an affidavit or other reasoned evidence, the rejection of claim 13 is *prima facie* deficient and should be reversed.

For at least these reasons, claims 36 and 40 are allowable over Kobe, Braun, and Tokas. As claims 37-39 depend from claim 36, each of these claims are also allowable over Kobe, Braun, and Tokas.

Therefore, it is respectfully requested that the rejection of claims 1-25 under 35 USC § 103(a), as being unpatentable over Kobe in view of Braun and Tokas, be reversed.

CONCLUSION:

In view of the foregoing, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the Examiner's rejections as to all of the appealed claims.

Respectfully submitted,

19 November 2008
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ATTORNEY AND AGENTS FOR APPELLANT

Claims Appendix
(37 C.F.R. § 41.37(c)(1)(viii))

Claim 1 (Previously Presented): A film comprising:
a dimensionally stable, thin plastic film having a smooth surface finish; and
a thin layer of silicone elastomer having a durometer disposed on a first surface
of the plastic film.

Claim 2 (Original): The film according to claim 1, wherein the plastic film is co-extruded, having a surface energy of less than about 40 Dynes/cm.

Claim 4 (Original): The film according to claim 1, further comprising:
an adhesive disposed on a second surface of the plastic film.

Claim 5 (Original): The film according to claim 4, further comprising:
a releasable liner for covering the adhesive prior to use.

Claim 6 (Original): The film according to claim 1, wherein the silicone elastomer
has a polished surface finish.

Claim 7 (Original) The film according to claim 6, wherein the polished surface
finish is smooth.

Claim 8 (Previously Presented): The film according to claim 6, wherein the polished surface finish is textured.

Claim 9 (Original): The film according to claim 6, wherein the polished surface finish is formed by a casting means having a polished surface finish.

Claim 10 (Original): The film according to claim 1, wherein the silicone elastomer has a textured and polished surface finish.

Claim 11 (Original): The film according to claim 10, wherein the texture is an array of upraised dimples.

Claim 12 (Previously Presented): The film according to claim 1, wherein the silicone elastomer has a matte surface finish.

Claim 13 (Previously Presented): The film according to claim 1, wherein the plastic film is a heat stabilized plastic film.

Claim 14 (Original): The film according to claim 1, wherein the plastic film has a thickness of about 0.002 inches or less.

Claim 15 (Original): The film according to claim 1, wherein the plastic film is tinted.

Claim 16 (Original): The film according to claim 1, further comprising:
graphical indicia associated with the plastic film.

Claim 17 (Original): The film according to claim 1, wherein the silicone elastomer
is tinted.

Claim 18 (Original): The film according to claim 1, further comprising:
graphical indicia associated with the silicone elastomer.

Claim 19 (Original): The film according to claim 1, wherein the film is configured
for application on the fingertips of users.

Claim 20 (Original): The film according to claim 1, wherein the film is configured
for application on handheld devices.

Claim 21 (Original): The film according to claim 1, wherein the film is configured
for placement onto a material handling device.

Claim 22 (Previously Presented): The film according to claim 21, wherein the
material handling device is a roller in a printer.

Claim 23 (Original): The film according to claim 1, wherein the film is configured for use on equipment used in games.

Claim 24 (Original): The film according to claim 1, wherein the film is configured to be sewn into fabric.

Claim 25 (Original): The film according to claim 1, further comprising:
a label stock having graphical indicia adhered to the plastic film, such that the graphical indicia is visible.

Claim 36 (Previously Presented): A silicone elastomer film, comprising:
a heat-stabilized, plastic film having a surface; and
a silicone elastomeric coating disposed on the surface of the film.

Claim 37 (Previously Presented): The silicone elastomer film, according to claim 36, wherein the heat-stabilized, plastic film exhibits a surface energy of less than about 40 Dynes/cm.

Claim 38 (Previously Presented): The silicone elastomer film, according to claim 36, wherein the elastomeric coating exhibits a durometer of less than 40 on the Shore A scale.

Claim 39 (Previously Presented): The silicone elastomer film, according to claim 36, wherein the elastomeric coating exhibits a durometer of less than 30 on the Shore A scale.

Claim 40 (Previously Presented): A silicone elastomeric film, comprising:

- a heat-stabilized, plastic film exhibiting a surface energy of less than about 40 Dynes/cm;
- a silicone elastomer layer disposed on a first surface of the heat-stabilized, plastic film, the silicone elastomer layer exhibiting a durometer of less than about 40 on the Shore A scale, the silicone elastomer layer defining a plurality of dimples extending outwardly from an exposed surface of the silicone elastomer layer;
- a release liner; and
- an adhesive adhered to a second surface of the heat-stabilized, plastic film and releasably adhered to a surface of the release liner.

Evidence Appendix
(37 C.F.R. § 41.37(c)(1)(ix))

Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, dated 10 March 2008,
entered into the record 12 March 2008.

Related Proceedings Appendix

(37 C.F.R. § 41.37(c)(1)(x))

There are no related appeals or declared interferences that will directly affect or be directly affected by a decision by the Board of Patent Appeals and Interferences (the “Board”) in the present appeal to the knowledge of Appellant’s representative.